

**Remarks**

In the office action mailed February 25, 2003, Applicants respectfully request reconsideration. For further prosecution of this application, Applicants submit the following remarks. The claims as presented are believed to be in allowable condition.

In the present application, independent claims 1, 2, 6, 7, 12, 16, and 17 have been amended and claim 18 has been cancelled. Claims 1 and 12 have been amended to clarify that the claimed method and computer-readable medium develop a media-content offering based on a subscriber attribute. Support for this amendment may be found on page 6, paragraph 19 and on page 9, paragraph 27 of the Specification. Applicants submit that this amendment does not affect the scope of the claims as originally filed as the deleted term "complementary to" is synonymous with "based on." Claims 1 and 12 have also been amended along with claim 16 to incorporate the recitations of cancelled claim 18 regarding the "subscriber attribute." Claims 1, 12, and 16 have been also amended to correct a typographical omission by adding the word "and" between the next to last and last clauses in each claim. Claims 6 and 7 have been amended to correct a typographical omission by adding the phrase "of delivering said" between "step" and "media-content." Dependent claims 2 and 17 have been amended to clarify that the "subscriber attribute" further comprises a "purchase history" based on the amendments of independent claims 1 and 16 respectively. No new matter has been added.

Claims 1-20 are currently pending in the application. Claims 1, 5, and 8-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lawler (U.S. Patent 5,758,259). Claims 2-4, 6, 7, and 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler.

### **Claim Rejections - 35 U.S.C. §102**

Claims 1, 5, and 8-16 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Lawler. The Lawler reference is directed to an automated selective programming guide. In particular, Lawler discloses a method for identifying for a viewer, selective programming on an interactive television (IT) system. In operation, the IT system identifies particular characteristics of programming including actor names and genres from television programs delivered to the selected viewer. Based on these programming characteristics, the viewer is presented with a programming guide that is automatically personalized based on the viewing history of the viewer. (See Col. 2, lines 3-33).

In contrast, amended claims 1 and 12 require analyzing a subscriber attribute in a subscriber database and developing a media-content offering based on the subscriber attribute, wherein the subscriber attribute comprises a demographic measure of the subscriber. The Lawler reference fails to teach or suggest developing a media-content offering based on a subscriber attribute comprising a demographic measure (e.g., age or income) of the subscriber. Thus, since Lawler fails to teach or suggest each and every element of amended claims 1 and 12, these claims are allowable and the rejections of these claims under 35 U.S.C. § 102(b) should be withdrawn.

Claims 5 and 8-11 depend from independent claim 1 and are thus allowable for at least the same reasons discussed above with respect to claim 1 above including the additional recitations cited therein. Similarly, claims 13-15 depend from independent claim 1 and are thus allowable for at least the same reasons discussed above with respect to claim 12 including the additional recitations cited therein. Therefore, the rejections of claims 5 and 8-11, and 13-16 under 35 U.S.C. § 102(b) should also be withdrawn. Amended independent claim 16 is directed

to similar novel features as amended independent claims 1 and 12 and is thus allowable for at least the same reasons as these claims. Specifically, Lawler fails to teach or suggest an attribute of a subscriber, wherein said attribute comprises a demographic measure of said subscriber. Therefore, the rejection of claim 16 under 35 U.S.C. § 102(b) should also be withdrawn.

### **Claim Rejections - 35 U.S.C. §103**

In the Office Action, claims 2-4, 6, 7, and 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler. Claim 18 has been cancelled and incorporated into amended independent claims 1 and 12. As amended, independent claims 1 and 12 incorporate the recitation of cancelled claim 18, these claims will also be discussed in view of the 35 U.S.C. § 103(a) rejection over Lawler. Beginning the discussion with amended claims 1 and 12, Lawler neither teaches nor suggests analyzing a subscriber attribute in a subscriber database and developing a media-content offering based on the subscriber attribute, wherein the subscriber attribute comprises a demographic measure of the subscriber, as required by amended claims 1 and 12.

The Office Action states that the claimed subscriber attribute (i.e., the demographic measure) would have been obvious because the attribute does not functionally relate to the steps in the claimed method and because the subjective interpretation of the attribute does not patentably distinguish the claimed invention. In support of this proposition, the Office Action cites *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). However, the cited authority in the Office Action is inapplicable here because, contrary to the Office Action, the attribute "demographic measure" is functionally related to the steps in the method and computer-readable medium claimed in amended claims 1 and 12 respectively. As discussed above, amended claims 1 and 12

require analyzing a subscriber attribute in a subscriber database and developing a media-content offering based on the subscriber attribute, wherein the subscriber attribute comprises a demographic measure of the subscriber. Thus, the development of the media-content offering is functionally related to a subscriber attribute, such as a demographic measure. In other words, without the subscriber attribute, the claimed invention as embodied in claims 1 and 12, would not be able to develop or deliver a media-content offering to the subscriber. Therefore, the aforementioned recitations in claims 1 and 12 patentably distinguish the invention from Lawler.

Claims 2-4, 6, and 7 depend from amended independent claim 1 and are thus allowable for at least the same reasons discussed above with respect to amended claim 1 as well as the additional recitations cited therein. For example, Lawler neither teaches nor suggests that the subscriber attribute further comprises a purchase history of the subscriber as recited in claim 2. Therefore, the rejections of claims 2-4, 6, and 7 under 35 U.S.C. § 103(a) should be withdrawn. Claims 17 and 19-20 depend from amended independent claim 16 and are thus allowable for at least the same reasons discussed above with respect to amended claim 16 as well as the additional recitations cited therein. Therefore, the rejections of claims 17 and 19-20 under 35 U.S.C. § 103(a) should also be withdrawn.

### **Conclusion**

In view of the foregoing amendments and remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicants' attorney at the number listed below.

The Applicants believe that no extension of time is required; however, this conditional petition is being made to provide for the possibility that the applicants have inadvertently

overlooked the need for a further additional extension of time. If any additional fees are required for the timely consideration of the application, please charge deposit account number 13-2725.

Respectfully submitted,

  
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